UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,899	02/15/2001	Shouichi Gotoh	MTS-3244US	6384

7590 01/09/2006

Allan Ratner
Ratner & Prestia
One Westlakes, Berwyn, Suite 301
P.O. Box 980
Valley Forge, PA 19482-0980

EXAMINER	
DURAN, ARTHUR D	
ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/783,899	GOTOH ET AL.	
	Examiner	Art Unit	
	Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-42 have been examined.

Response to Amendment

2. A new reference has been added to the 35 USC 103 rejection to further demonstrate the obviousness of the stated features.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-42 are rejected under 35 U.S.C. 103(a) as being obvious over Ebisawa 5,886,731 in view of Ellis (2004/0194131) in view of Muyres (2002/0002488).

As per independent claim 1, Ebisawa (the ABSTRACT; FIG. 1; FIG. 2; FIG. 4; FIG. 5B; FIG. 11; col. 2, ll. 7-30; col. 1, ll. 7-11; col. 10, ll. 27-55; and col. 8, ll. 37-41) discloses: *"The present invention relates to a video data receiving apparatus receiving video data, a video data transmitting apparatus transmitting video data broadcasting system distributing video data. . . . And the receiving state information data are stored by the external storing unit . . . for example, the floppy disk . . . with the user identification code data which is added to the information and transmitted. . . . The storing unit **207** is a storage means for storing the program data stream and CM data stream inputted from*

to store 20 minutes worth of AV data. . . . AV data of 30 seconds each is inserted . . . As a result, the output AV data becomes as shown in FIG. 5B. Namely, the viewer views a Cm of 30 seconds every 30 minutes. . . . Note that, to enable such a reception, the storing unit 207 must have a storage capacity enough to store data of at least the amount of output of the CM. . . ." The Examiner interprets this disclosure as showing: "An advertisement supplying method, characterized in that an area for recording advertisement data is created in a large-capacity recording medium located at a user's location, advertisement data which are to be reproduced when an audience watch a program are recorded in said area in advance of the user watching the program, and said large-capacity recording medium is thereafter provided to the user, and after creating the advertisement data in the user's large-capacity recording medium, selectively synthesizing the program watched by the user with portions of the advertisement data previously created and stored in the user's large-capacity recording medium."

As per independent claim 2, Ebisawa (col. 1, ll. 30-45; the ABSTRACT; FIG. 1; FIG. 2; FIG. 4; FIG. 5B; FIG. 11; col. 2, ll. 7-30; col. 1, ll. 7-11; col. 10, ll. 27-55; and col. 8, ll. 37-41) discloses the features of the elements of claim 2 which is similar to claim 1.

Ebisawa lacks an explicit recitation of "a free area for recording advertisement data is created. . . ."

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Ebisawa (col. 1, ll. 30-45; the ABSTRACT; FIG. 1; FIG. 2; FIG. 4; FIG. 5B; FIG. 11; col. 2, ll. 7-30; col. 1, ll. 7-11; col. 10, ll. 27-

55; and col. 8, ll. 37-41) shows "a free area for recording advertisement data is created. . . ." and it would have been obvious to modify and interpret the disclosure of Ebisawa cited above as showing "a free area for recording advertisement data is created. . . .", because modification and interpretation of the cited disclosure of Ebisawa would have provided *"a video data receiving apparatus which displays a program with appropriate insertions of CMs in a form in accordance with the desires of the viewer. . . ."* (see Ebisawa (col. 1, ll. 45-50), based on the motivation to modify Ebisawa so as to provide *"a video data transmitting apparatus which transmits CM data and program data so that a receiving apparatus displays a program with appropriate insertions of CMs in a form in accordance with the desires of the viewer. . . ."* (see Ebisawa (col. 1, ll. 50-55).

As per claims 3, 6, 8, 10, 12, 14, 16, 18, 20, 22, 24, 26, 28, 30, 32, or 36 and 37, Ebisawa shows the method of claim 1 and subsequent base claims depending from claim 1.

Ebisawa (col. 1, ll. 30-45; the ABSTRACT; FIG. 1; FIG. 2; FIG. 4; FIG. 5B; FIG. 11; col. 2, ll. 7-30; col. 1, ll. 7-11; col. 10, ll. 27-55; and col. 8, ll. 37-41; and whole document) shows the elements of claims 3, 6, 8, 10, 12, 14, 16, 18, 20, 22, 24, 26, 28, 30, 32, or 36 and 37.

As per claims 4, 5, 7, 9, 11, 13, 15, 17, 19, 21, 23, 25, 27, 29, 31, 33, 34, 35, or 36 and 38, Ebisawa shows the method of claim 2 and subsequent base claims depending from claim 2.

Ebisawa (col. 1, ll. 30-45; the ABSTRACT; FIG. 1; FIG. 2; FIG. 4; FIG. 5B; FIG. 11; col. 2, ll. 7-30; col. 1, ll. 7-11; col. 10, ll. 27-55; and col. 8, ll. 37-41; and whole document) shows the elements of claims 4, 5, 7, 9, 11, 13, 15, 17, 19, 21, 23, 25, 27, 29, 31, 33, 34, 35, or 36 and 38.

Independent claim 39 is rejected for substantially the same reasons as independent claim 1.

As per claims 40-42, Ebisawa shows the system of claim 39.

Ebisawa (col. 1, ll. 30-45; the ABSTRACT; FIG. 1; FIG. 2; FIG. 4; FIG. 5B; FIG. 11; col. 2, ll. 7-30; col. 1, ll. 7-11; col. 10, ll. 27-55; and col. 8, ll. 37-41; and whole document) shows of the elements of claims 40-42.

Additionally, Ellis discloses:

Storing separate sets of advertisement data in the user's separate storage medium, prior to receiving the sets of advertisement data; after storing the separate sets of advertisement data in the user's storage medium, selectively synthesizing the program data received with portions of the separate sets of advertisement data; and/or

Advertisement data is first stored in the user's storage medium and subsequently the user receives a television program that also includes other sets of advertisement data; and/or

Storing, at a location separate from the user's location, the separate sets of advertisement data in the user's separate storage medium; and subsequently placing the user's separate storage medium at the user's location; receiving the sets of advertisement data and program data at the user's location, after the placing of the user's separate storage medium; and/or

Advertisement data is stored in a user's system, next (b) the user's system is placed at the user's location (for example, home), next (c) the system receives program data and advertisement data from the television broadcasting station, and finally (d) the system selectively synthesizes the program data, the advertisement data received from the broadcasting station, and the other advertisement data that was previously stored in the system at a different location; and/or

Receiving and storing advertisement data at a location other than the user's location (a store, for example). . .placing the system at the user's location and, subsequently receiving program data and other advertisement data from the television station.

Ellis discloses these features at the following citations and throughout the Ellis disclosure (Fig. 1; Fig. 22; and Paragraph 0136):

"[0136] It is to be understood that for the purpose of scheduling interactive advertisements, interactive advertisements include interactive displays which provide user help information or draw attention to advertising space. Interactive displays that provide user help information or draw attention to advertising space may be assigned a default priority. Default priority advertisements may reside at user television equipment (e.g., as part of the application code at set-top box 70 of FIG. 1) and may only be displayed if no other advertisements are available. For example, as shown in FIG. 22, the information stored in data table 300 provides that the interactive advertisements for "Help Text" and "Available Space" have default priority and that a day part may not be applicable to default priority advertisements. In operation according to data table 300, display screens 302 and 304 include the default priority "Help Text" and "Available Space" advertisements (respectively) because the other advertisements of higher priority have not been received yet or are scheduled for a different day part. Advertisements

such as default priority advertisements may be distributed separate from other advertisements. For example, default priority advertisements may be received and stored earlier for repeated presentation over several day parts, weeks, months, etc. Default priority advertisements may be stored as part of the application or as part of non-volatile memory".

Notice in this citation from Ellis that the default advertisements are separate from the advertisements that are downloaded, that the advertisements are stored earlier than the other advertisements, and that the advertisements can be stored as part of the application or as part of non-volatile memory. Hence, the default advertisements can be stored as part of the instructions or memory that come with the hardware device itself.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Ellis earlier stored advertisements and separate more frequently downloaded advertisements to Ebisawa's downloading of advertisements and synthesizing with content. One would have been motivated to do this in order to be able to provide advertisements if no other advertisements are available.

As a further example of this, Muyres (20020002488) discloses that advertising or marketing content or data or content or software can be preloaded/preinstalled/prestored on a variety of hardware devices prior to the device being placed at the user's location (below citation and throughout the Muyres disclosure):

"[0338] As was the case in describing the problems which the present invention can address in the Background Art section, the above discussion has primarily used PCs as an example. But the invention can solve problems beyond the context of just PCs. A PC is just one

type of personal computerized device or system and a hard drive is just one type of primary storage unit. Those skilled in the relevant arts will readily recognize that the present invention can be used to initially provide and maintain, offer and vend, deliver or enable, configure and service digital content in a wide range of primary storage units and personal computerized systems (and potentially in small and enterprise networks as well). The examples noted, without limitation, in the Background Art section bear some reconsideration in view of this. Gaming stations, like Sony Playstation (.TM.) and Microsoft's X-box (.TM.) have a hard drive which can be pre-loaded with digitally wrapped game software, clue books, advertising, etc. The user can then view or use this, or may obtain a digital key to unwrap and promptly be able to use such. The same process works well for personal communication service (PCS) devices, television "set-top" boxes like WebTV (.TM.), Internet enabled cellular telephones; and personal digital assistants (PDAs), albeit to provide more than just game related digital content. And the same process works with "personal devices" that handle text, audio, image data and its capture, storage, playback, communication, etc.

[0340] . . . and delivery of assets 22 from the local inventory 18 is virtually instantaneous, is guaranteed, and is free. In sum, the customers 40 may receive superior service, gain confidence in, and have access to what they want (which as described below, can be pre-loaded, and even default configured, i.e., virtually assuring that it will work)."

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Muyres' preloaded content onto a variety of hardware devices prior to the device being placed at the user's location to Ellis' default advertisements that are

separate from the advertisements that are downloaded, and that are stored earlier than the other advertisements, and that can be stored as part of the application code or as part of non-volatile memory. One would have been motivated to do this in order to provide default advertisements that are ready for display/utilization.

Response to Arguments

3. Applicant's arguments with respect to claims 1-42 have been considered but are moot in view of the new ground(s) of rejection. Please particularly note the section added to the rejection of the claims above that begins with, "Additionally, Ellis discloses. . .".

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arthur Duran
Primary Examiner
1/4/2006